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Paper No.

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**MAY 13 2004**

In re Application of:	:	
Stantchev et al.	:	<b>OFFICE OF PETITIONS</b>
Application No. 10/632,303	:	DECISION REFUSING
Filed: August 1, 2003	:	STATUS UNDER
Title of Invention: METHODS AND	:	37 CFR 1.47(a)
APPARATUS FOR IMAGING	:	

This is in response to a petition under 37 CFR 1.47(b), filed March 31, 2004, to allow a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, to make application on behalf of and as agent for all inventors. The petition is properly treated under 37 CFR 1.47(a), to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s).

The petition is dismissed.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)", and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on August 1, 2003, without an executed oath or declaration. This Office mailed a Notice to File Corrected Application Papers (hereinafter "Notice") on October 29, 2003, requiring, *inter alia*, an oath or declaration in compliance with 37 CFR 1.63.

In response to the Notice, Applicant files the instant petition wherein Applicant avers that diligent effort has been made to receive the nonsigning inventor's cooperation. This assertion is supported by the Declaration of Daniel J. Noblitt, wherein Mr. Noblitt avers that he has attempted to contact the nonsigning inventor about eight to ten times over the past five months. Mr. Boblitt asserts that he has forwarded various documents relating to this application to the nonsigning inventor, and has also discussed the need for the nonsigning inventors participation in the application with the nonsigning inventor's attorney, who believes the nonsigning inventor has moved to Australia, inhibiting the ability of the attorney to effectively communicate with the nonsigning inventor.

It is initially noted that 37 CFR 1.47(b) does not apply in this situation. Thirty seven CFR 1.47(b) applies when none of the inventors has executed the declaration, and then allows a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, to make application on behalf of and as agent for all inventors.

Alternatively, 37 CFR 1.47(a) is applicable where at least one inventor has executed the declaration, and is filed to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s).

There is no provision in the regulations that allow for an entity that has a partial or majority interest in an application to proceed with the application on behalf of a nonsigning inventor.

Within 37 CFR 1.47(a), two separate and distinct circumstances exist that to allow an inventor (or inventors) to proceed with the examination of an application without the signature of the inventor(s). The first is where an inventor refuses to sign an application after having been presented with the application for signature, and the second is where an inventor cannot be found or reached after diligent effort. Both situations are separate and distinct and require separate and distinct steps in order to allow a petition under 37 CFR 1.47(a) or (b) to be granted. In this instance, Applicant avers that diligent effort has been made to receive the nonsigning inventor's cooperation.

Applicable Law

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) and (2) as set forth above.

As to item (1), if an inventor is unavailable (cannot be reached), while it is not required that the application be mailed, Petitioner must establish the exercise of diligent effort in trying to find or reach the nonsigning inventor. A statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor. (Emphasis supplied). See, MPEP § 409.03(d). At the very least, an Internet search, or a search of telephone directories should be undertaken of the regions where it is suspected the non-signing inventor may reside. Copies of the results of such searches must be referred to in any renewed petition. It is important that the forthcoming communication contain statements of fact as opposed to conclusions.

As to item (2), Applicant has failed to provide an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116. A review of the oath or declarations filed with the instant petition reveals that each oath or declaration is a separate oath or declaration that lists only one inventor. There are no page numbers on the oath or declaration to indicate that there may be more inventors, there is no indication that the separate declarations are part of a single document.

As required by 37 CFR 1.63, the (single) oath or declaration must identify each inventor to the other inventors. "When joint inventors execute separate oaths or declarations, each oath or declaration should make reference to the fact that the affiant is a joint inventor together with each of the other inventors *indicating them by name.*" MPEP § 602. (Emphasis supplied).

Further to this, the Manual for Patent Examining Procedure ("MPEP"), section 409.03(a) provides:

All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.75 (see MPEP § 602, § 605.01, and § 1414) and (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors *with the signature block of the nonsigning inventor(s) left blank* may be treated as having been signed by all the available inventors on behalf of the nonsigning inventor(s) unless otherwise indicated. (Emphasis supplied).

MPEP 409.03(a).

The Declaration must list all inventors and be signed by the available inventors. See, MPEP 409.03. A properly executed oath or declaration is required.

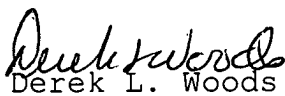
Further correspondence with respect to this matter should be addressed as follows:

By mail:           Commissioner for Patents  
                    PO Box 1450  
                    Alexandria, VA 22313-1450

By FAX:           (703) 872-9306  
                    Attn: Office of Petitions

By hand:           2201 South Clark Place  
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                    Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0014.

  
Derek L. Woods  
Petitions Attorney  
Office of Petitions